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U.S. Application No. 10/717,892 Examiner Desir Art Unit 2617
Response to May 22, 2007 Office Action

REMARKS

In response to the Office Action dated May 22, 2007, the Assignee respectfully requests reconsideration based only on the following remarks. The Assignee respectfully submits that the pending claims already distinguish over the cited documents. The Assignee also respectfully asserts that the pending claims are ready for allowance.

Claims 1-3 and 5-20 are pending in this application, with independent claim 20 being newly presented. Claim 4 was previously canceled without prejudice or disclaimer.

Double-Patenting Rejection

Claims 1-3 and 5-19 were rejected for obvious-type double patenting over the claims of U.S. Patent 7,127,051. The Assignee, however, must, very respectfully, disagree with this rejection. While the pending claims recite some features that are similar to the claims of U.S. Patent 7,127,051, the pending claims are patentably distinct. Independent claims 1, 11, and 20, for example, each recite "*monitoring a duration of said call traversing the service-providing network.*" This feature is not recited in the claims of U.S. Patent 7,127,051, so this feature would not be anticipated nor obviated by the claims of U.S. Patent 7,127,051. The Assignee, then, respectfully asserts that the pending claims are patentably distinct over the claims of U.S. Patent 7,127,051. The Assignee thus respectfully requests removal of the obvious-type double patenting rejection.

Rejection of Claims over *Fuller & Jones*

Claims 1-3, 5-8, 10-14, 16, and 18-19 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,775,546 to Fuller in view of U.S. Patent 6,195,422 to Jones *et al.*

These claims, however, cannot be obvious. These claims recite, or incorporate, features that are not taught or suggested by *Fuller* and *Jones*. Independent claim 1, for example, recites

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"the virtual telephone number associated with a dialed telephone number in the native transport network" (emphasis added). The combined teaching of *Fuller* and *Jones*, in contradistinction, operates entirely opposite. In *Fuller*, a caller dials a single directory number, or "common 'virtual fixed line' number," to reach a mobile subscriber. U.S. Patent 6,775,546 to Fuller (Aug. 10, 2004) at column 1, line 65 through column 2, line 12 (emphasis added). *Fuller* then explains that "the common virtual fixed line number is converted in Step 2 into two or more MSISDNs." U.S. Patent 6,775,546 to Fuller (Aug. 10, 2004) at column 6, lines 24-26. In *Fuller* and *Jones*, then, a caller dials the "common 'virtual fixed line' number" and that number is converted to an MSISDN.

Fuller and *Jones*, however, operate entirely opposite from the pending claims. In the pending claims, a call is received that is *"directed to a virtual telephone number in a service-providing network, the call originating from a native transport network."* The independent claims also recite *"the virtual telephone number [is] associated with a dialed telephone number in the native transport network"* (emphasis added). So, in the pending claims, a caller dials a telephone number in the originating, native transport network, but the call is received *"directed to a virtual telephone number in a service-providing network."* In *Fuller*, a caller dials the "common 'virtual fixed line' number," and that "common virtual fixed line number" is converted into multiple MSISDNs. In the independent claims, however, a caller dials a telephone number in the originating, native transport network, but the call is received *"directed to a virtual telephone number in a service-providing network."* As the independent claims recite, *"the virtual telephone number [is] associated with a dialed telephone number in the native transport network"* (emphasis added). These claimed features are fully explained in paragraph [0031] of the as-filed application.

The combined teaching of *Fuller* and *Jones*, then, cannot obviate the pending claims. The combined teaching of *Fuller* and *Jones* operates entirely opposite from the independent claims. *Fuller* and *Jones* fails to teach or suggest *"receiving a call directed to a virtual telephone number in a service-providing network, the call originating from a native transport network having limited capability of providing advanced telephony service, the virtual telephone number*

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associated with a dialed telephone number in the native transport network, the service-providing network providing intelligent services to said call, wherein the virtual telephone number utilizes the intelligent services provided by the service-providing network" (emphasis added). Because *Fuller* and *Jones* are both silent to these features, one of ordinary skill in the art would not think that independent claims 1, 11, and 20 are obvious. The Office, then, is respectfully requested to remove the § 103 (a) rejection of claims 1-3, 5-8, 10-14, 16, and 18-19.

Rejection of Claims 9, 15 & 17

Claims 9, 15, and 17 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Fuller* in view of *Jones* and further in view of U.S. Patent Application Publication 2003/0050100 to *Dent*. As the above paragraphs explained, *Fuller* and *Jones* are both silent to all the claimed features of independent claims 1, 11, and 20. The additional disclosure of *Dent* does not cure these deficiencies. *Dent* describes telecomm equipment (e.g., an antenna) that is shared by multiple service providers. See U.S. Patent Application Publication 2003/0050100 to *Dent* at paragraph [0006]. Because the equipment is shared, *Dent* also discloses billing schemes to account for each service provider's usage. See *id.* at paragraphs [0016] and [0023] through [0025].

Still, though, *Fuller*, *Jones*, and *Dent* fails to teach or suggest all the claimed features. As the above paragraphs explained, claims 9, 15, and 17, respectively, depend from independent claims 1 and 11. Claims 9, 15, and 17, then, incorporate these same distinguishing features and recite additional features. Because the combined teaching of *Fuller*, *Jones*, and *Dent* fails to disclose all the claimed features, one of ordinary skill in the art would not think that claims 9, 15, and 17 are obvious. The Office, then, is respectfully requested to remove the § 103 (a) rejection of claims 9, 15, and 17.

Fuller "Teaches Away"

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Any combination involving *Fuller* “teaches away” from the pending claims. “A reference that ‘teaches away’ from the claimed invention is a significant factor” when determining obviousness. See M.P.E.P. at § 2145 (X)(D)(1). A reference must be considered as a whole, including portions that lead away from the claimed invention. See *id.* at § 2141.02; see also *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). “It is improper to combine references where the references teach away from their combination.” M.P.E.P. at § 2145 (X)(D)(2). If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. See M.P.E.P. at § 2143.01.

The *prima facie* cases all require an impermissible change to *Fuller*’s principle of operation. As the above paragraphs explained, *Fuller*’s principle of operation is to convert a “common ‘virtual fixed line’” number into two or more MSISDNs. U.S. Patent 6,775,546 to Fuller (Aug. 10, 2004) at column 6, lines 24-26. In *Fuller*, a caller dials a telephone number in the originating, native transport network, but the call is received “*directed to a virtual telephone number in a service-providing network.*” In *Fuller*, a caller dials the “common ‘virtual fixed line’ number,” and that “common virtual fixed line number” is converted into multiple MSISDNs. In the independent claims, however, a caller dials a telephone number in the originating, native transport network, but the call is received “*directed to a virtual telephone number in a service-providing network.*” As the independent claims recite, “*the virtual telephone number [is] associated with a dialed telephone number in the native transport network*” (emphasis added). Because *Fuller* requires that a caller dials the “virtual fixed line number,” *Fuller* cannot associate this virtual fixed line number “*with a dialed telephone number in the native transport network,*” as is recited in independent claims 1, 11, and 20 (emphasis added). *Fuller*’s principle of operation, then, must be changed to support the Examiner’s rejections. Because the patent case law prohibits changing a principle of operation to support a *prima facie* case, any proposed combination involving *Fuller* “teaches away” and cannot support the § 103 rejections of the pending claims.

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If any issues remain outstanding, the Office is requested to contact the undersigned at
(919) 469-2629 or scott@scottzimmerman.com.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized flourish at the end.

Scott P. Zimmerman
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